



Patent
Attorney's Docket No. 018656-107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Manami KUISEKO et al) Group Art Unit: 2873
Application No.: 09/450,271) Examiner: Timothy J. Thompson
Filed: November 26, 1999) Confirmation No. 7399
For: REFLECTING MICROOPTICAL)
SYSTEM)

TECHNOLOGY CENTER 2800

RECEIVED
AUG -4- 2003

REQUEST FOR WITHDRAWAL OF THE FINALITY OF THE OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The most recent Office Action, dated July 21, 2003, sets forth rejections of claims 9, 10 and 28 which are based upon the newly-cited Tsunashima patent (U.S. Patent No. 6,169,637). The Office Action was made final, but does not provide any basis for the finality. It is respectfully submitted that the finality of the Office Action is premature, and its withdrawal is therefore respectfully requested.

The most recent Office Action is responsive to Appellants' Brief, filed April 16, 2003. As pointed out in the Brief, the previous Office Action dated September 16, 2002 did not set forth a rejection of claims 9, 10 or 28. That omission is acknowledged in the most recent Office Action, which includes a rejection of those three claims. However, since the rejection is based upon newly-cited prior art, it is improper to make the Action final, since it precludes the development of a clear issue between the Examiner and the Applicants on the relevance of that new reference.

Request for Withdrawal of the Finality of the Office Action
Application No. 09/450,271
Attorney's Docket No. 018656-107
Page 2

MPEP §706.07(a) states "second or any subsequent actions on the merits shall be final, *except* where the Examiner introduces a new ground of rejection *that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement . . .*" (emphasis added). The most recent Office Action does not contain any showing, nor even an allegation, that the citation of the new prior art was "necessitated" by an amendment, or is based on information from an Information Disclosure Statement. Applicants' prior response to the Office Action dated September 16, 2002 did not introduce any amendments to the claims. Furthermore, the response submitted previous to that, on August 19, 2002, only amended claims 9 and 28 to remove the word "strongly", in response to a rejection under the second paragraph of 35 U.S.C. §112. The deletion of this word from the claims did not "necessitate" the subsequent citation of the Tsunashima patent. Specifically, it did not introduce any substantive changes to the scope of the claims which required the citation of that patent. If claims 9, 10 and 28 are properly rejectable on the basis of the Tsunashima patent, such a rejection should have been set forth in one of the previous Office Actions. The failure to do so precludes the most recent Office Action from being made final.

Request for Withdrawal of the Finality of the Office Action
Application No. 09/450,271
Attorney's Docket No. 018656-107
Page 3

Accordingly, Applicants respectfully request that the finality of the Office Action dated July 21, 2003, be withdrawn, as premature.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 31, 2003

By: 
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620